

DETAILED ACTION

1. This action is responsive to the adverse decision by the BPAI on 5/6/09. Claims 1-25, 27-39, and 41-44 are pending. Claims 26 and 40 were previously canceled and claims 27-36 were previously withdrawn from consideration. PROSECUTION IS HEREBY REOPENED. A new ground of rejection has been set forth below. A TC director has approved reopening prosecution by signing below.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 22-25, 39, and 43 are rejected under 35 U.S.C. 101 because they are directed towards non-statutory subject matter. Claim 22 claims essentially a computer program that accomplishes recited tasks (see specification page 2, lines 19-21 and page 15, lines 24-26). The program of claim 22 is not a machine, manufacture, or composition of matter. Furthermore, the tangible computer readable medium of the claim is not part of the program being claimed. Therefore, it cannot be used to establish a statutory category. Thus, claims 22-25, 39, and 43 are essentially software per se.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 43 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claim 43 seems to be referring to "The system of claim 22". However, claim 22 is a computer program and no other claims are directed towards a system claim.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4, 10-15, 21-25, 37-39, and 41-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barsness (US PG PUB 2008/0082620 A1) further in view of Isaacs et al (US Patent No 7,043,530) hereinafter referred to as Issacs.

As to claim 1, Barsness teaches a communications method comprising:

establishing a text instant messaging communication session between a sender and a recipient through an instant messaging host (0007, 0050, an instant messaging session is established via an instant message server);

facilitating a text instant message to be sent from the sender to the recipient during the session, the text instant message including message text inputted by the sender (0050, an instant message sent by a user is retrieved by the instant messaging server and displayed on the recipient's screen);

enabling presentation of a first text instant messaging graphical user interface to the recipient that includes the display of the message text, the presentation of the text instant message graphical user interface being conditioned on communication of the text instant message between the sender and the recipient (0050, the recipient is alerted to an incoming instant message by a pop-up window displaying the message)

However, Barness does not explicitly indicate that the graphical user interface includes an icon such that by enabling manipulation by the recipient of the icon, voice communication is invoked between the sender and the recipient through the instant messaging host.

Issacs teaches a system in which text instant messages and sound instant messages are exchanged between users (col 4, lines 14-17). Issacs further teaches enabling manipulation by the recipient of an icon to invoke voice communication between the sender and the recipient through the instant messaging host (col 6, lines 15-21 and col 7, lines 44-67, users may communicate with one another by sending voice instant messages. For example, a user may want to terminate a session with Bonnie and sends here a voice instant message saying "BYE" by selecting the "BYE" icon).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Issacs into those of Barness to make the system more efficient and enhance user experience. By using dedicated icons to send simple messages, users can quickly contact each other and make arrangements in a personal manner (col 9, lines 47-56). By utilizing sound, a user's experience is

enhanced as email and traditional text-based instant messaging have become impersonal (col 1, lines 40-51)

As to claim 2, Barness teaches the method of claim 1 further comprising receiving and authenticating the text instant message from the sender at the instant messaging host (0033, 0036).

As to claim 3, Barness teaches the method of claim 2 wherein authenticating the text instant message comprises identifying a screen name associated with at least one of the sender and the recipient (0035).

As to claim 4, Barness teaches the method of claim 2, wherein authenticating the text instant message comprises identifying an IP address associated with at least one of the sender and the recipient (0029, 0035)

As to claim 10, Barness teaches the method of claim 1, further comprising receiving at the instant messaging host, a request to establish communication (0042, 0050). However, Barness does not explicitly indicate establishing a voice communication.

Issacs teaches establishing voice communication (col 8, lines 16-31).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Issacs into those of Barness to enhance user experience. By utilizing sound, a user's experience is enhanced as email and traditional text-based instant messaging have become impersonal (col 1, lines 40-51)

As to claim 11, Issacs teaches wherein the request is from the sender (col 8, lines 16-31).

As to claim 12, Issac teaches wherein the request is from the recipient (col 6, lines 15-21 and col 7, lines 44-67).

As to claim 13, Barness teaches the method of claim 10 further comprising authenticating request (0033, 0036).

As to claim 14, Barness teaches the method of claim 11 wherein authenticating the request comprises identifying a screen name associated with at least one of the sender and the recipient (0035).

As to claim 15, Barness teaches the method of claim 11, wherein authenticating the request comprises identifying an IP address associated with at least one of the sender and the recipient (0029, 0035)

As to claim 20, Barness teaches a communications apparatus comprising and instant message host configured to:

establishing a text instant messaging communication session between a sender and a recipient (0007, 0050, an instant messaging session is established via an instant message server);

facilitating a text instant message to be sent from the sender to the recipient during the session, the text instant message including message text inputted by the sender (0050, an instant message sent by a user is retrieved by the instant messaging server and displayed on the recipient's screen);

enabling presentation of a first text instant messaging graphical user interface to the recipient that includes the display of the message text, the presentation of the text instant message graphical user interface being conditioned on communication of the

text instant message between the sender and the recipient (0050, the recipient is alerted to an incoming instant message by a pop-up window displaying the message)

However, Barness does not explicitly indicate that the graphical user interface includes an icon such that by enabling manipulation by the recipient of the icon, voice communication is invoked between the sender and the recipient through the instant messaging host.

Issacs teaches a system in which text instant messages and sound instant messages are exchanged between users (col 4, lines 14-17). Issacs further teaches enabling manipulation by the recipient of an icon to invoke voice communication between the sender and the recipient through the instant messaging host (col 6, lines 15-21 and col 7, lines 44-67, users may communicate with one another by sending voice instant messages. For example, a user may want to terminate a session with Bonnie and sends here a voice instant message saying "BYE" by selecting the "BYE" icon).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Issacs into those of Barness to make the system more efficient and enhance user experience. By using dedicated icons to send simple messages, users can quickly contact each other and make arrangements in a personal manner (col 9, lines 47-56). By utilizing sound, a user's experience is enhanced as email and traditional text-based instant messaging have become impersonal (col 1, lines 40-51)

As to claim 22, Barness teaches a computer program, stored on a tangible computer readable medium, comprising instructions for:

establishing a text instant messaging communication session between a sender and a recipient through an instant messaging host (0007, 0050, an instant messaging session is established via an instant message server);

facilitating a text instant message to be sent from the sender to the recipient during the session, the text instant message including message text inputted by the sender (0050, an instant message sent by a user is retrieved by the instant messaging server and displayed on the recipient's screen);

enabling presentation of a first text instant messaging graphical user interface to the recipient that includes the display of the message text, the presentation of the text instant message graphical user interface being conditioned on communication of the text instant message between the sender and the recipient (0050, the recipient is alerted to an incoming instant message by a pop-up window displaying the message)

However, Barness does not explicitly indicate that the graphical user interface includes an icon such that by enabling manipulation by the recipient of the icon, voice communication is invoked between the sender and the recipient through the instant messaging host.

Issacs teaches a system in which text instant messages and sound instant messages are exchanged between users (col 4, lines 14-17). Issacs further teaches enabling manipulation by the recipient of an icon to invoke voice communication between the sender and the recipient through the instant messaging host (col 6, lines

15-21 and col 7, lines 44-67, users may communicate with one another by sending voice instant messages. For example, a user may want to terminate a session with Bonnie and sends here a voice instant message saying "BYE" by selecting the "BYE" icon).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Issacs into those of Barness to make the system more efficient and enhance user experience. By using dedicated icons to send simple messages, users can quickly contact each other and make arrangements in a personal manner (col 9, lines 47-56). By utilizing sound, a user's experience is enhanced as email and traditional text-based instant messaging have become impersonal (col 1, lines 40-51)

As to claim 23, Barness teaches the computer program of claim 22 wherein the computer readable medium is a disc (0037, 0039).

As to claim 24, Barness teaches the computer program of claim 22 wherein the computer readable medium is a client device (0040, 0041)

As to claim 25, Barness teaches the computer program of claim 22 wherein the computer readable medium is a host device (0035).

As to claim 37, Barness teaches the method of claim 1 wherein the communications are invoked responsive to receiving a text instant message, however does not explicitly indicate wherein the communication is voice communication.

Issacs teaches establishing voice communication (col 8, lines 16-31).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Issacs into those of Barness to enhance user experience. By utilizing sound, a user's experience is enhanced as email and traditional text-based instant messaging have become impersonal (col 1, lines 40-51)

As to claim 38, Barness teaches the apparatus of claim 21, wherein the instant messaging host is configured to enable communication responsive to a text message being received. However, Barness does not explicitly indicate that the communication is voice communication.

Issacs teaches establishing voice communication (col 8, lines 16-31).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Issacs into those of Barness to enhance user experience. By utilizing sound, a user's experience is enhanced as email and traditional text-based instant messaging have become impersonal (col 1, lines 40-51)

As to claim 39, Barness teaches the computer program of claim 22, wherein the instructions for communications are invoked responsive to receiving a text instant message, however does not explicitly indicate wherein the communication is voice communication.

Issacs teaches establishing voice communication (col 8, lines 16-31).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Issacs into those of Barness to enhance user experience. By utilizing sound, a user's experience is enhanced as email and traditional text-based instant messaging have become impersonal (col 1, lines 40-51)

As to claim 41, Barness teaches the communications method of claim 1, wherein the presentation of the first text instant messaging graphical user interface being conditioned on communication of the text instant message comprises not presenting the first text instant messaging graphical user interface if the text instant message is not received by the recipient (0050).

As to claim 42, Barness teaches the communications apparatus of claim 21, wherein the presentation of the first text instant messaging graphical user interface being conditioned on communication of the text instant message comprises not presenting the first text instant messaging graphical user interface if the text instant message is not received by the recipient (0050).

As to claim 43, Barness teaches the computer system of claim 1, wherein the presentation of the first text instant messaging graphical user interface being conditioned on communication of the text instant message comprises not presenting the first text instant messaging graphical user interface if the text instant message is not received by the recipient (0050).

Allowable Subject Matter

8. Claim 44 is allowed.
9. Claims 5-9 and 16-20 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

10. The art made of record and not relied upon is considered pertinent to applicant's disclosure.

A) PowWow Guided Tour – Step 6, PowWow Personal Communicator.

B) Okuyama et al US Patent 7,437,413.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ASAD M. NAWAZ whose telephone number is (571)272-3988. The examiner can normally be reached on M-F 8-4:30.

12.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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